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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,175	10/15/1999	GREGORY T. OSTERHOUT	11032RR	9870

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EXAMINER

TRAN, PABLO N

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/419,175

Applicant(s)

OSTERHOUT ET AL.

Examiner

Pablo N Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) 9-16, 34-42 and 52-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 17-33, 43-51 and 70-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8, 17-33, 43-51, and 70-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 17, the claimed limitation "transmitting the new address to which the incoming call is to be redirected" rendered the claim indefinite. Is the new address is being transmitted to a location. If it is than where does this new address being transmitted to or is it that the incoming call will be transmitted to the new address. The examiner will interpret as that the incoming call will be transmitted to the new address of another device. Appropriated correction is required.

Regarding claims 25 and 43, the claimed limitation "wherein the sending of the registration notification causes the called party to be provided with an option to redirect routing of the call to another address" rendered the claim indefinite. Is "another address" the same as the new address? Appropriated correction is required.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 8, 17-21, 24-26, 28, 30-33, 43-44, 46, 48-51, and 70-81 are rejected under 35 U.S.C. 102(b) as being anticipated by *Pepe et al.* (5,742,905).

As per claims 1, 17, 25, 43, 70, 72-73, 75-76, 78-79, and 81, *Pepe et al.* disclosed a method for redirecting a call from a data processing apparatus to another device wherein receiving at the data processing apparatus (fig. 24/no. 30, col. 30/ln. 40-42) a registration notice of an incoming call from a server (fig. 24/no. 48), responsive to the registration notice-providing a user with an option to redirect the routing of the call prior to establishing a communication connection between an originator of the incoming call and the data processing apparatus, receiving user input in response to providing the option to redirect the routing of the incoming call-wherein the user input identifies a new address of another device to which the incoming call is to be routed, and responsive to receiving the user input-the incoming call will be transmitted to the new address of another device (col. 30/ln. 40-66).

As per claims 2-5, 8, 18-21, 24, 28, 33, 46, and 51, *Pepe et al.* disclosed such that the data processing apparatus is of a PDA, laptop computer, portable computing device, wireless device, or a wire-line device (fig. 1-3).

As per claims 30-31, 48-49, 71, 74, 77, and 80, *Pepe et al.* disclosed such that the user has the option to place the incoming on hold or redirect to a voice mailbox (col.

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30/ln. 40-col. 31/ln. 13, wherein it is clear that the user can type in a message and request that the caller stay on the phone and the user will answer the call momentarily).

As per claims 32, 50, *Pepe et al.* disclosed utilizing wireless application protocol (col. 7/ln. 21-col. 8/ln. 53, col. 16/ln. 1-23)

As per claims 26 and 44, *Pepe et al.* disclosed prior to said sending step-receiving a request to initiate a call with a called party and determining a preferred location of the called party (col. 30/ln. 28-56).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 22, 27, 29, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over by *Pepe et al.* (5,742,905).

As per claims 6, 22, 27, and 45, *Pepe et al.* disclosed various protocols are being utilized but not explicitly SIP. However, such is notoriously well known in the art that the examiner takes Official Notice of such. Therefore, it would have been obvious to one of ordinary skill in the art to provide such parlay protocol to the personal communication internetworking system of *Pepe et al.* in order to effectively provide notification of such events as incoming calls to the user.

As per claims 29 and 47, *Pepe et al.* disclosed various portable devices such as a PDA but not explicitly a Palm VII utilized a device. However, such is notoriously well known in the art that the examiner takes Official Notice of such. Therefore, it would have been obvious to one of ordinary skill in the art to provide such device to be utilized in the personal communication internetworking system of *Pepe et al.* in order to expand functionality of the device and provide flexibility and portability to the user.

7. Claims 7 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over by *Pepe et al.* (5,742,905) in view of *French-St. George et al.* (6,122,348).

As per claims 7 and 23, *Pepe et al.* disclosed the incoming call is of various media formats but not explicitly video and select the appropriate video device. However, such is notoriously well known in the art, as disclosed by *French-St. George et al.* (col. 4/ln. 6-41). Therefore, it would have been obvious to one of ordinary skill in the art to provide such media format to be utilized in the personal communication internetworking system of *Pepe et al.* in order to provide such signaling structure that enables a user to manage the receipt of the incoming signaling messages.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Titmuss et al. (6,167,122), Pepper et al. (5,930,700), and Shaffer et al. (5,911,123) disclose such call forwarding method in a radiotelephone communication system.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703)305-4385.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:


(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

**PABLO N. TRAN
PRIMARY EXAMINER**

February 18, 2005



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